

Application No. 10/716,362  
Amendment dated January 4, 2006  
Reply to Office Action of August 4, 2005

### Remarks

Claims 1-13 are currently pending in this application.

The Office Action rejected claims 1-13 under 35 U.S.C. § 103(a) as being unpatentable over Pursley (U.S. Patent No. 6,364,421) in view of McKay (U.S. Patent Application Pub. No. 2003/0154569).

By this Amendment, Applicants have amended claim 1. Applicants respectfully traverse the Section 103(a) rejection of claims 1-13, for the following reasons.

In establishing a *prima facie* case of obviousness under 35 U.S.C. 103, the examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. See MPEP §2143 (Aug. 2005). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore the courts require that the art be analogous to serve as a proper basis for rejection under 35 U.S.C. 103.

The present invention recited in, for example, claim 1, and claims 2-13 at least by virtue of dependence, comprises a combination of elements, including a wheel balancing device comprising, *inter alia*, an elongate backing strip having a top surface removably attached to the bottom surface of said tape, said backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing said backing strip from said tape.

Pursley discloses a wheel balancing device comprising a backing strip 50 which is wider than the weights to form a gripping surface 52. The Office Action admits that Pursley fails to disclose a

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backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing the backing strip.

Contrary to the Office Action's broad interpretation of McKay to the point that it is taken out of its inventive contextual environment, McKay simply discloses a lint removal apparatus with a pull tab for adhesive coated sheets. The pull tabs of McKay are layers on top of each other and do not have intervening layers of adhesive in between each layer of material that forms the pull tab. (See page 2 paragraph 40, non-adhesive area 32). The pull tabs do not form, nor are they part of a backing strip. McKay addresses the need for improved devices with multiple layers of tape wherein fresh layers of exposed adhesive are critical to the continued operation of the device. The problem being solved is the fact that the separation of layers of adhesive is tedious, cumbersome and slow. By placing an intervening pull tab that is unencumbered by adhesive forces but adhesively attached to a flexible layer of adhesive, a user can rapidly access the tab and remove the used adhesive layer.

The Office Action uses impermissible hindsight to justify the combination of Pursley and McKay. There is no disclosure in either Pursley or McKay suggesting that these references may be combined. This alone makes the obviousness rejection improper. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929 (Fed. Cir. 1984) (obviousness cannot be established by combining the teachings of the prior art to produce the claimed inventions, absent some teaching, suggestion or incentive supporting the combination). The Federal Circuit strongly reiterated this point in *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). In *Sang Su Lee*, the Court held that the PTO must give full reasoning as to what motivation or teaching in the prior art would suggest combining references relied upon in an obviousness rejection; and that an Examiner's general common knowledge and common sense do not substitute for the authority

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required by law to reject a claim for obviousness.

Without a motivation to combine these references, the Office Action relies upon the generalized statement "it would have been obvious to provide backing strip of the balance weight strip of Pursley with [sic] serrations to allow easier removal of the backing strip at the location of the break in the weights, and further provide a tab to assist in grasping the backing strip for removal", in an attempt to combine the references. There is nothing in these references suggesting a wheel balancing device comprising, *inter alia*, an elongate backing strip having a top surface removably attached to the bottom surface of said tape, said backing strip having a plurality of transverse serrations that form lift tabs to facilitate removing said backing strip from said tape, without reference to the present application. Thus, the Office Action's assertions merely represent the Examiner's general common knowledge and common sense. Such common knowledge and common sense cannot substitute for the authority required by law to reject a claim for obviousness.

There is no reasonable expectation of success from the combination Pursley and McKay disclosed by the prior art and not the applicant's disclosure. The pull tabs of McKay are in a completely different environment than the present invention. The pull tabs of McKay are not designed to both fully interface with adhesive and retain their pull tab function. The McKay disclosure expressly states their operation is contingent upon the area that forms the pull tabs as being "non-adhesive". (See page 2 paragraph 40, non-adhesive area 32). The discontinuities of McKay (42) the Office Action points to as disclosing the serrations of the present invention are not designed to permit the retention of the integrity of a strip of weights. Nor are they designed to permit the easy separation of weights attached to a back or to permit a living hinge to exist between weights. (Applicant specification pages 7, line 14 to page 9 line 14). Instead, they are designed solely to

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make a pull tab readily accessible for a user to remove a layer of adhesive tape material from another layer of adhesive tape material. Therefore, one of ordinary skill in the relevant art would conclude that taking the lint roller pull tab design of McKay and placing it in the wheel balancing art would not have a reasonable expectation of success.

The combination of Pursley and McKay if combined do not suggest all the claim elements of the present invention. Obviousness only permits the Examiner to look to additional references to find all the claimed elements, the Examiner must still establish the presence of all the elements within the references. (MPEP 706.02(j)). The combination of Pursley and McKay is improper because they do not set forth "an elongate continuous tape having a top surface and a bottom surface, the bottom surface of said tape having an adhesive for attaching said tape to a rim of a wheel." The rejection's device would be cumbersome and/or non-functional. The proposed combination destroys the device of Pursley. The device would go against the teachings of the instant invention because McKay would require several tape free zones at the interface between all the weights. The absence of tape between all the weights will cause the user to attach weights one at a time instead of having the option of attachment in sets. (See the specification text that bridges the bottom of page 7 to the top of page 8). Otherwise having a continuous tape would preclude the pull tabs of McKay from functioning, because McKay discloses they require the absence of adhesive in order to serve as pull tabs. (See McKay page 2 paragraph 40).

Applicant's claimed invention is not rendered obvious by the proposed combination. Either the combination is improper because it destroys the base reference of Pursley or it does not have all the claimed elements of Applicant's instant invention.

Furthermore, McKay is not analogous prior art and, therefore, is not properly combined with

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Pursley. "[T]wo criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 966 F.2d 656, 658-59, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992). The lint removal apparatus of McKay is clearly not in the same field of endeavor as Pursley—a wheel balancing device. McKay addresses the need for improved devices and methods for simple cleaning duties such as removing lint, pet hair, and dandruff from clothing or floors. In contrast, the present invention addresses the need for adhesive wheel balancing weights that eliminate waste caused by contaminated adhesive, enables individual weights to be separated quickly and easily, without a cutting tool, and permits the backing strip to be quickly and easily removed from the adhesive tape. One of ordinary skill in the wheel balancing device art would not look to the lint removal apparatus art for solutions to the problems addressed by the present invention.

In light of this and the nonanalogous nature of McKay, Applicants respectfully assert that Pursley and McKay are not properly combinable. Applicants further submit that each of Pursley and McKay fails to disclose or suggest the combination of elements recited in claims 1-13. Thus, these claims are allowable over these references. Therefore a *prima facie* case of obviousness is not established by Pursley in view of McKay, and applicant respectfully requests that this rejection be withdrawn. Applicants further request reconsideration of the application, and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 03-2775. If a fee is required for an extension of time under 37.

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C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: January 4, 2006

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